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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,268	02/11/2002	Tomoya Takahashi	02139.000029	9453

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EXAMINER

KIM, VICKIE-Y

ART UNIT PAPER NUMBER

1614

DATE MAILED: 04/18/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/049,268

Applicant(s)

TAKAHASHI ET AL.

Examiner

Vickie Kim

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-49 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-7, 23-28, drawn to a hair-growing agent comprising lysophosphatidic acids and/or phosphatidic acids wherein the fatty acid residue moiety consists only of straight-chain fatty acid residues having an even number of carbon atoms.

Group II, claim(s) 8,10, 13, 17-22, 29, 31, 34, 34, 37, 40-41 and 43, drawn to a hair growing agent comprising (a) lysophosphatidic acids and/or phosphatidic acids; and (b) proanthocyanidin, protein kinase C-specific inhibitors or tocopherol.

Group III, claims 9, 10, 11, 17-22, 29, 30-34, 36-40 and 42-43 , drawn to a hair growing agent comprising lysophosphatidic acids, phosphatidic acids or proanthocyanidin, and optionally additives.

Group IV, claims 12, 13, 14, 17, 18, 19, 20, 21, 22, 35 and 41 drawn to a hair growing agent comprising lysophosphatidic acids, phosphatidic acids or protein kinase C-specific inhibitors , and optionally additives.

Group V, claims 15, 16, 17, 18, 19, 20, 21 and 22 , drawn to a hair growing agent comprising lysophosphatidic acids, phosphatidic acids or tocopherol, and optionally additives.

Group VI, claim 44 drawn to a method for hair growth using the composition of the group I.

Group VII, claims 45-46, drawn to a method for hair growth using the composition of the group II.

Group VIII, claim 47, drawn to a method of preparing hair growing composition of the group I.

Group IX, claim 48, drawn to a method of preparing hair growing composition of the group II.

The invention listed as Group I-IX do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the special technical feature which is referred to Annex B of Appendix A1 of the MPEP(Administrative Instructions under the PCT, "Unity of Invention"). Unity exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding claimed technical features. The express "special technical features" is defined as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art."(Rule 13.2). The question of unity of invention has been reconsidered retroactively by the examiner in view of the search performed; a review of US4515778 or JP63091306 makes clear that the claimed species is not novel over the prior art . Furthermore, these references appear to demonstrate that the claimed species does not define a contribution which each of the inventions, considered as a whole, makes over the prior art. Accordingly, the prior art of the record supports restriction of the claimed subject matter in to the groups as mentioned immediately above.

Election of Species

2. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Upon the election of the patentably distinct invention of the group, applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. Each group contains sets of combination composition wherein the species are as follows: lysophosphatidic acids (formula I, II, and III), phosphatidic acids, proanthocyanidin, protein kinase C-specific inhibitors or tocopherol. Because the numerous different combinations can be made possibly based on the species elected, applicant is required to elect a single disclosed species(e.g. specific example of the possible combination), from under the instant claims of the elected group. Moreover, whatever specific compound is ultimately elected, applicants are required to list all claims readable thereon. With the election of a specific exemplified compound, a generic concept will be identified by the examiner as the inventive group for examination. For instance, if the patentably distinct invention of the group is elected, the species for active ingredient, and optional ingredient should be elected so that accurate examination can be reasonably carried out.

The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: As mentioned earlier, the claimed species and its use in treatment for hair loss are not novel and the species lack the special technical features. It is noted that a reference to one enhanced combination of drugs would not be a reference to another combination of drugs. In other words, one combination composition is not anticipatory or obvious over the other combinations. Further, the claims read on a multitude of enhanced combinations of drugs which would require many field of searches that would be an undue burden on the examiner. Therefore, restriction for examination purposes is proper.

Conclusion

3. No claim is allowed. All the pending claims are subject to the restriction requirement.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickie Kim whose telephone number is 703-305-1675. The examiner can normally be reached on Tuesday-Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on 703-308-4725. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-3165 for regular communications and 703-746-3165 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

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A handwritten signature in black ink, appearing to read 'Vickie Kim', with a long horizontal flourish extending to the right.

Vickie Kim,
Patent examiner
April 10, 2003
Art unit 1614

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